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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,647	10/06/2003	Takashi Tokutani	1503.68508	3934

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EXAMINER	
PICH, PONNOREAY	
ART UNIT	**PAPER NUMBER**
2135	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/679,647	TOKUTANI ET AL.	
	Examiner	Art Unit	
	Ponnoreay Pich	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on ~~24 May 2004~~. 10/6/03

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 10/6/03 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Thanhnga B. Truong
AU2135

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 5/2004.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-11 are pending.

Priority

Foreign priority claim to Japanese document 2002-296778 is noted. However, foreign priority claim has not yet been perfected because while a certified copy of the foreign priority document has been received, no translation of the document is on file as required by 35 USC 119(b)(3).

Information Disclosure Statement

The IDS filed on 5/27/2004 has been considered.

Claim Objections

Claims 1-11 are objected to because of the following informalities:

1. Claim 1 recites "encrypted private data" in line 3. Later recitations of "the private data" in claim 1 and its dependent claims (specifically claims 3, 5-9) should instead be "the encrypted private data" so as to maintain consistency. Claims 10 and 11 contain similar informalities.
2. In claim 3, TRM should be spelled out—"Tamper Resistant Module (TRM)".
3. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The limitations further recited in claims 8 and 9 appear to contain translation errors and/or run-on sentences, thus the claims are indefinite. Applicant is respectfully requested to double check the wording of the claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

1. Claim 10 is not statutory because the claim is directed towards a program, which is software per se. Software by itself is not patentable.
2. Claim 11 is directed towards an apparatus comprising various units to perform a method as recited in claim 1. It would appear that these units could be implemented via software alone, thus claim 11 is not statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurst et al (US 2003/0007646).

Claims 1 and 10-11:

As per claim 1, Hurst discloses:

1. Receiving encrypted private data (paragraph 19);
2. Receiving an encrypted private data use license which describes a decryption key, i.e. content key, for decrypting the private data, and a use condition, i.e. business rules/binding attributes, of the private data (paragraphs 19, 36-38, and 62);
3. Decrypting the decryption key and the private data use license (paragraph 62);
4. Determining whether or not a use purpose of the private data matches the use condition described in the private data use license (paragraph 62); and
5. Decrypting the private data by using the decrypted decryption key only if the use purpose of the private data matches the use condition (paragraph 62).

Claim 11-12 recite limitations similar to what is recited in claim 1 and are rejected for substantially the same reasons. The difference is that claim 11 is directed towards a

program which performs the method of claim 1 and claim 12 is directed towards an apparatus comprising units to perform the method of claim 1.

Claim 2:

Hurst further discloses wherein the decryption key and the private data use license are encrypted and decrypted by using a DRM authentication technology (paragraphs 52 and 62).

Claim 3:

Hurst further discloses wherein a mechanism for decrypting the private data use license by using a DRM authentication technology is implemented as a Tamper Resistant Module (TRM) (paragraphs 46 and 61).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurst et al US 2003/0007646) in view of Peinado et al (US 6,775,655).

Claim 4:

Hurst does not explicitly disclose the following limitation, but it is disclosed by Peinado: wherein the use condition of the private data use license includes at least any

of an expiry date, a number of available times, a use purpose, and a number of move times of the private data use license (col 1, lines 50-58 and col 2, lines 61-67).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Hurst's invention according to the limitations recited in claim 4 in light of Peinado's teachings. One skilled would have been motivated to do so because Peinado discloses that content owners may wish to limit use of their digital content in the manners disclosed by Peinado (col 1, lines 50-58).

Claim 5:

Hurst further discloses wherein the use purpose includes a restriction on an application which uses the private data (paragraph 36).

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurst et al US 2003/0007646) in view of Cooper et al (US 2001/0051996) and further in view of Peinado et al (US 6,775,655).

Claim 6:

Hurst discloses receiving the encrypted private data, and the encrypted private data use license which describes the decryption key for decrypting the private data, and the use condition of the private data (paragraphs 19, 36-38, and 62).

However, Hurst does not explicitly disclose the receiving is from a plurality of information entities. However, Cooper discloses receiving from a plurality of information entities (paragraph 253).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Hurst's invention such that the receiving is from a plurality of information entities. One skilled would have been motivated to do so because it would distribute network load amongst a plurality of locations, thus achieving load balancing and prevent any one information entity from being overloaded (Cooper: paragraph 253). Note that Cooper discloses that this is a widespread practice in the industry.

Hurst also does not explicitly disclose creating a name list license by concatenating a plurality of private data use licenses which have same conditions; and creating a name list by concatenating encrypted private data which correspond to the private use licenses used to create the name list license.

However, Peinado discloses creating a name list license by concatenating a plurality of private data use licenses which have same conditions (col 21, lines 3-23). At the time applicant's invention was made, it would have been obvious to one skilled in the art to further modify Hurst's invention using Peinado's teachings by creating a name list license by concatenating a plurality of private data use licenses which have same conditions. One skilled would have been motivated to do so because use of a name list license would prevent the need to search for and load multiple licenses for a digital content, thus accessing the digital content is more efficient.

Further, official notice is taken that use of a play list was well known in the art at the time applicant's invention was made. Creation of a content play list from encrypted media which requires licenses to play the media reads on creating a name list by concatenating encrypted private data which correspond to the private use licenses used

to create the name list license. At the time applicant's invention was made, it would have been obvious to further modify Hurst's invention according to the limitations recited in claim 6. One skilled would have been motivated to do so because use of a play/name list allows a user to consecutively play multiple files without having to manually load each file.

Claim 7:

As per claim 7, Hurst further discloses wherein the encrypted private data can be decrypted with a decryption key possessed by an information entity that transmits the private data (paragraphs 57 and 62).

Claim 8:

As per claim 8, Cooper further discloses wherein if the private data is provided to a different information device, at least any one of a name, a type, a use purpose, and an inquiry destination of an organization which manages a different information device to which the private data is provided, and a provided item list of a private data database is created for each information entity, and disclosed to a corresponding information entity depending on need (paragraphs 18-19).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hurst et al US 2003/0007646) in view of Cooper et al (US 2001/0051996) and further in view of Peinado et al (US 6,775,655) and further in view of Floyd et al (US 6,243,692).

Claim 9:

As per claim 9, Hurst does not explicitly disclose receiving corrected contents if a correction is made to at least one of the encrypted private data, and the private data use license which describes the decryption key for decrypting the private data, and the use condition of the private data; and transmitting the corrected contents to a different information device to secure sameness of the private data and the private data use license. However, Floyd discloses the limitation (col 5, lines 34-48).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to further modify Hurst's invention according to the limitations recited in claim 9 in light of Floyd's teachings. One skilled would have been motivated to do so because it would allow the end user to upgrade from one content module to another (col 5, lines 34-36).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ponnoreay Pich
Examiner
Art Unit 2135

PP

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